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UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL
PROPERTY AND DIRECTOR OF THE UNITED STATES
PATENT AND TRADEMARK OFFICE
Washington, D.C. 20231

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**DIRECTOR'S OFFICE
TECHNOLOGY CENTER 3600**

In re Application of
James H. Wolfston
Application No. 09/300,881
Filed: April 28, 1999
For: METHOD AND APPARATUS FOR
INCREASING CHARITABLE
DONATIONS BY PROVIDING
INSTANTANEOUS DONOR
RECOGNITION

DECISION ON
PETITION TO WITHDRAW
FINALITY OF ACTION
UNDER 37 CFR 1.181

This is in response to applicant's petition received on September 3, 2002 in which applicant has requested that the Finality of the April 3, 2002 Office action be withdrawn.

The Petition is **GRANTED**.

Applicant argues that in the Final rejection dated April 3, 2002 the examiner set forth new grounds of rejection on all of the claims while the amendment dated March 5, 2002 only contained amendments to claims 8, 13-15, and new claims 21-28. As such the Final rejection should be considered premature.

A review of the file history indicated that the examiner sent out a non-final Office action on October 22, 2001. In response to this action applicant submitted a response on March 5, 2002 in which claims 8, and 13-15 were amended and new claims 21-28 added. Just looking to the independent claims 6 and 17 it is clear that there were no changes to either of these claims and that the examiner did in fact apply a new grounds of rejection to both of these claims.

The MPEP 706.07(a) sets forth that a "second or subsequent action on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement...". Based on the facts in the case the Finality of the April 3, 2002 was premature and as such is hereby withdrawn. As for the RCE papers and the request for the related fees to be refunded, since the RCE has not yet been processed there have not been any related fees charged.

In summary, the finality of the April 3, 2002 Office action is hereby withdrawn. The RCE papers filed will be placed in the file but not processed. The application will be forwarded to the Supervisory Legal Instruments Examiner to have the amendment after Final dated July 15, 2002 entered and the application forwarded to the examiner for prompt action on this amendment. The Advisory Action of July 25, 2002 mailed in response to the above-noted amendment is hereby **VACATED** since it is an improper response to an amendment responding to the now non-Final Office action of April 3, 2002.

Inquiries related to this decision may be directed to Supervisory Patent Examiner Robert Olszewski at (703) 308-5183.



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RO/SM: 06/15/03